



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Claiborne, C.F.

PATENT

Serial No.: 09/741,388

Patent Case No.: 20282DA

Art Unit: 1625

Filed: December 20, 2000

Examiner:

P.L. Morris

For: SUBSTITUTED IMIDAZOLES HAVING  
CYTOKINE INHIBITORY ACTIVITY

Assistant Commissioner for Patents  
Alexandria, VA 22313-1450

REQUEST FOR STATUS

Sir:

Please advise the applicant as to the status of the U.S. Patent Application No.  
09/741,388.

On November 16, 2001 a Restriction Requirement was mailed to Applicant by the USPTO (Tab A). A timely response was mailed by the Applicants on November 21, 2001 (Tab B). Apparently, this response was lost in the mail, possibly as a result of the anthrax situation in the fall/winter of 2001. A notice of abandonment was issued July 10, 2002 (Tab C). On July 2002, Applicants responded with a Petition Under 37 C.F.R. 1.181(a) to withdraw holding of Abandonment on July 18, 2002 (Tab D).

There has been no activity since. Moreover, the Petition to withdraw Abandonment does not seem to have been acknowledged by return postcard or on the USPTO's PAIR system.

Applicants would be grateful if the Examiner would ascertain the status of this case, and take any and all appropriate action to issue an Office Action on the merits of the selected claims.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date appearing below.

MERCK & CO., INC.

By JS Date 6-6-2003

Serial No.: 09/741,388  
Case No.: 20282DA  
Page No.: 2

If there are any issues requiring discussions, it is requested that the Examiner contact the undersigned at (732) 594-2675.

Respectfully submitted,

By David Rubin  
David Rubin  
Reg. No. 40,314  
Attorney for Applicants  
Merck & Co., Inc.  
P.O. Box 2000  
Rahway, NJ 07065-0907  
(732) 594-2675

Date: June 5, 2003

1. This application is (still pending \_\_\_\_\_).  
(abandoned \_\_\_\_\_).
2. Office Action on this application can be expected on or about \_\_\_\_\_; or
3. Office Action on this application was mailed on \_\_\_\_\_.



# P&T OFFICE ACKNOWLEDGEMENT

ATTORNEY

DAVID RUBIN

DATE

June 5, 2003

CASE NUMBER

20282DA

SERIAL NUMBER

09/741,388

DATE FILED

DECEMBER 20, 2000

APPLICANT

CLAIBORNE, C.F.

EXPRESS MAIL NO.

The Patent & Trademark Office acknowledges, and has stamped hereon, the date of the receipt of the items checked below:

- ☐ AMENDMENT
- ☐ APPEAL AND FEE
- ☐ ASSIGNMENT
- ☐ BRIEF
- ☐ CERTIFICATE OF CORRECTION
- ☐ FINAL FEE
- ☐ LETTER
- ☐ REQUEST FOR F.F. LICENSE
- ☐ INFORMATION DISCLOSURE STATEMENT
- ☐ PTO 1449 & REFERENCES
- ☐ PETITION FOR EXTENSION OF TIME & FEE
- ☐ INVITATION TO CORRECT
- ☐ DEMAND-CHAPTER II & FEE SHEET

X Request for Status



ROCKETE  
NOV 21 2001  
BARBARA DE

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Christopher F. Claiborne, et al.		
Serial No.:	09/741,388	Case No.:	20282DA
Filed:	December 20, 2000		
For:	SUBSTITUTED IMIDAZOLES HAVING CYTOKINE INHIBITORY ACTIVITY		
		Art Unit:	1625
		Examiner:	P.L. Morris

The Honorable Assistant Commissioner for Patents  
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Restriction Requirement mailed November 16, 2001 for which the deadline to respond is December 16, 2001, Applicants respectfully submit that it will not be burdensome for the Examiner to include Claims 5-13, dependent from Claim 1, in the present prosecution because a search for compounds according to formula (I) wherein X represents nitrogen would uncover any uses and preparations of such compounds. Accordingly, Applicants respectfully request that Claims 5-13, dependent from Claim 1 as amended, remain in the present application. In any event, Applicants respectfully elect Claims 1, 2, and 4 without prejudice to their pursuit of any unelected subject matter in any continuing or divisional application.

Attorney for Applicants can be reached at the telephone number and address

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date appearing below.

MERCK & CO., INC.

By John M. Lee Date 21 Nov. 2001

below. Correspondence should continue to be sent to the address below. Any additional fees or deficiency in fees required should be taken from Merck Deposit Account No. 13-2755.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date appearing below.

MERCK & CO., INC.

By Shu M. Lee Date 21 Nov. 2001

Respectfully submitted,

By Shu M. Lee

Shu M. Lee

Reg. No. 41,147

Attorney for Applicants

MERCK & CO., Inc.

P.O. Box 2000

Rahway, New Jersey 07065-0907

(732) 594-2675

Date: November 21, 2001



# P&T OFFICE ACKNOWLEDGEMENT

ATTORNEY Shu muk Lee DATE 11/21/2001  
CASE NUMBER/ 20282DA SERIAL NUMBER 09/741,388  
DATE FILED Christopher F. Chiboreng, et al,  
APPLICANT

EXPRESS MAIL NO.

The Patent & Trademark Office acknowledges, and has stamped hereon, the date of the receipt of the items checked below:

- ☐ AMENDMENT
- ☐ APPEAL AND FEE
- ☐ ASSIGNMENT
- ☐ BRIEF
- ☐ CERTIFICATE OF CORRECTION
- ☐ FINAL FEE
- ☐ LETTER
- ☐ REQUEST FOR F.F. LICENSE
- ☐ INFORMATION DISCLOSURE STATEMENT
- ☐ PTO 1449 & REFERENCES
- ☐ PETITION FOR EXTENSION OF TIME & FEE
- ☐ INVITATION TO CORRECT
- ☐ DEMAND-CHAPTER II & FEE SHEET

X Response to Restriction Requirement.

F4424



# P&T OFFICE ACKNOWLEDGEMENT

ATTORNEY <i>Shu M. Lee</i>		DATE <i>7-18-2002</i>
CASE NUMBER/ <i>20282 DA</i>	SERIAL NUMBER <i>09/741,388</i>	
DATE FILED <i>December 20, 2000</i>		
APPLICANT <i>Christopher F. Claiborne, et al.</i>		
EXPRESS MAIL NO.		

The Patent & Trademark Office acknowledges, and has stamped hereon, the date of the receipt of the items checked below:

- ☐ AMENDMENT
- ☐ APPEAL AND FEE
- ☐ ASSIGNMENT
- ☐ BRIEF
- ☐ CERTIFICATE OF CORRECTION
- ☐ FINAL FEE
- ☐ LETTER
- ☐ REQUEST FOR F.F. LICENSE
- ☐ INFORMATION DISCLOSURE STATEMENT
- ☐ PTO 1449 & REFERENCES
- ☐ PETITION FOR EXTENSION OF TIME & FEE
- ☐ INVITATION TO CORRECT
- ☐ DEMAND-CHAPTER II & FEE SHEET
- ☒ *Petition Under 37 CFR 1.181(a) To*
- ☒ *Withdrawal Holding of Abandonment*
- ☒ *Nov. 21, 2001 Resp. to Restriction Requirement*

SMZ

20282DA



UNITED STATES PATENT AND TRADEMARK OFFICE

JUN 10 2003  
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PATENT & TRADEMARKS

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,388	07/10/2002	Christopher F. Claiborne	20282DA	6177

210 7590 07/10/2002

MERCK AND CO INC  
PO BOX 2000  
RAHWAY, NJ 070650907

EXAMINER

MORRIS, PATRICIA L

ART UNIT PAPER NUMBER

1625

DATE MAILED: 07/10/2002

5

SHU M. LEE  
JUL 16 2002  
PATENT DEPARTMENT

Reply Due  
8/10/02

(abandoned in error)

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED  
JUL 16 2002  
PATENT DEPARTMENT





**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER
	5

DATE MAILED:

**NOTICE OF ABANDONMENT**

This application is abandoned in view of:

- ☒ Applicant's failure to respond to the Office letter, mailed 11/16/01.
- ☐ Applicant's letter of express abandonment which is in compliance with 37 C.F.R. 1.138.
- ☐ Applicant's failure to timely file the response received \_\_\_\_\_ within the period set in the Office letter.
- ☐ Applicant's failure to pay the required issue fee within the statutory period of 3 months from the mailing date of \_\_\_\_\_ of the Notice of Allowance.
  - ☐ The issue fee was received on \_\_\_\_\_.
  - ☐ The issue fee has not been received in Allowed Files Branch as of \_\_\_\_\_.

In accordance with 35 U.S.C. 151, and under the provisions of 37 C.F.R. 1.316(b), applicant(s) may petition the Commissioner to accept the delayed payment of the issue fee if the delay in payment was unavoidable. The petition must be accompanied by the issue fee, unless it has been previously submitted, in the amount specified by 37 C.F.R. 1.17(l), and a verified showing as to the causes of the delay.

If applicant(s) never received the Notice of Allowance, a petition for a new Notice of Allowance and withdrawal of the holding of abandonment may be appropriate in view of *Delgar Inc. v. Schuyler*, 172 U.S.P.Q. 513.

- ☐ Applicant's failure to timely correct the drawings and/or submit new or substitute formal drawings by \_\_\_\_\_ as required in the last Office action.
  - ☐ The corrected and/or substitute drawings were received on \_\_\_\_\_.
- ☐ The reason(s) below.

PATRICIA L. FERRIS  
PRIMARY EXAMINER  
ENCLOSURE



UNITED STATES PATENT AND TRADEMARK OFFICE

JUN 10 2003

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,388	12/20/2000	Christopher A. Chabone	20282DA	6177

210 7590 11/16/2001

MERCK AND CO INC  
P O BOX 2000  
RAHWAY, NJ 070650007

EXAMINER

MORRIS, PATRICIA L

ART UNIT

PAPER NUMBER

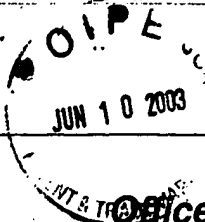
1625

DATE MAILED: 11/16/2001

NOV 20 2001

BARBARA RE

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No. 09/741,382	Applicant(s) Claiborne et al
Examiner H. Morris	Group Art Unit 1625

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE One MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 2 and 4-13 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1, 2 and 4-13 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1625

## DETAILED ACTION

### *Election/Restriction*

This application has been found to contain more than one invention. Therefore, restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2 and 4, drawn to compounds, classified in class 546, subclass 274.1.
- II. Claims 5 and 13, drawn to a method of preparing, classified in class 514, various subclasses.
- III. Claims 6-12, drawn to multiple uses, classified in class 514, various subclasses.

The inventions are distinct, each from the other because of the following reasons:

These distinct inventions have acquired separate status in the art, will support separate patents, and will require different fields of search for the respective inventions. Accordingly, restriction for examination purposes as indicated is considered proper; 35 U.S.C. 121; 37 CFR 1.141; 37 CFR 1.142.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the products as claimed can be made by materially different processes as evidenced by applicants' own specification.

Art Unit: 1625

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products as claimed can be used in materially different processes as evidenced by applicants' own claims and specification..

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicants are requested to elect a single disclosed method of use, i.e. a specific disease upon an election of Group IV.

Should applicant(s) traverse on the ground that the species inventions identified are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the above identified species inventions to be obvious variants, or clearly admit on the record that this is the case. In either instance, of traverse, if the examiner finds one of the inventions in the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

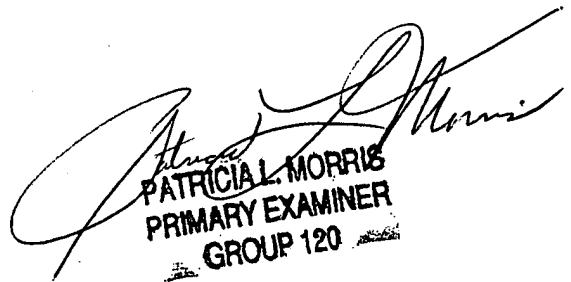
In, In re Weber, 198 USPQ 332, In re Hengehold, 169 USPQ 473, was noted for the proposition that as long as applicants have maintained the right (as they do here) to file the non-elected subject matter in divisional applications, then restriction is proper, as to that point.

Art Unit: 1625

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

This restriction requirement is being written as previous experience has indicated that with Foreign applicants and the inherent time delays, applicants' representative is better able to make an informed, correct, election of the invention applicants would wish to have prosecuted here if applicants are given the opportunity to see the restriction requirement laid out, and given the time to make an informed decision.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Morris whose telephone number is (703) 308-4533.

  
PATRICIA L. MORRIS  
PRIMARY EXAMINER  
GROUP 120

plm

November 14, 2001

**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.